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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Duncan ) Art Unit: 2173  
Serial No.: 09/829,249 ) Examiner: Basom  
Filed: April 9, 2001 ) ARC9-2001-0027US1  
For: **ELECTRONIC BOOK WITH MULTIMODE I/O** ) April 23, 2004  
750 B STREET, Suite 3120  
San Diego, CA 92101

APPEAL BRIEF

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellant's Notice of Appeal filed herewith.

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**(1) Real Party in Interest**

The real party in interest is IBM Corp.

**(2) Related Appeals/Interferences**

No other appeals or interferences exist which relate to the present application or appeal.

**(3) Status of Claims**

Claims 1-5 and 6-20 are pending and finally rejected.

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**(4) Status of Amendments**

An amendment cancelling Claims 21-31 has been submitted and presumably will be entered for purposes of appeal.

**(5) Summary of Invention**

Using Claim 1 as an example, the invention is an electronic book having a portable housing and a processor in the housing and displaying content stored in a storage device by responding to plural input modes, and outputting the content using plural output modes. As more specifically set forth in Claim 1, the processor responds to a graphics input mode by outputting content in a graphics output mode using a graphic user interface, and it also responds to an audio input mode by outputting content in an audio output mode using an audio user interface.

**(6) Issues**

(a) Whether Claims 1-5 and 6-12 are unpatentable under 35 U.S.C. §103 as being obvious over Oberteuffer et al. in view of Kono.

(c) Whether Claims 13-20 are unpatentable under 35 U.S.C. §103 as being obvious over Oberteuffer et al. in view of Kono.

**(7) Grouping of Claims**

The rejected claims are grouped as indicated above owing to the different ways in which they characterize the invention and the different grounds and reasons for rejecting them used by the examiner.

For instance, different portions of the references have been used to reject Claims 1 and 13, e.g., to account for the abstract interface set forth in Claim 13 but not Claim 1. Thus, the rejections of the independent claims, relying as they do on respective portions and interpretations of the references, should be individually considered.

**(8a) Argument**

Claim 1 requires (1) responding to a graphics input mode by outputting content in a graphics output mode using a graphic user interface, and (2) also responding to an audio input mode by outputting content in an audio output mode using an audio user interface. In contrast, Oberteuffer et al. accepts voice input and handwriting input for digitizing them into computer files and then uses *one and only one* output mode, whereas Kono accepts *only* a touch screen-generated query to output requested data in audio and text. And in this simple exposition the deficiency in the Office Action is laid bare.

For even if the references were combined as proposed, there is no suggestion that the combination would result the graphics-graphics and audio-audio input and output correspondences required by Claim 1. The reason, of course, is simple. Since Oberteuffer et al. does not envision multiple output modes, and Kono does not envision multiple input modes, how can plural input-output correspondences be suggested by either? Instead, all the references fairly suggest, even assuming it is proper to combine them, is to add Kono's multiple output modes to Oberteuffer's multiple input modes *but not* with audio output being generated in response to audio input and graphics output generated in response to graphics input, as required by Claim 1. The proposed combination would merely result in allowing a user to input data using voice or handwriting, as taught by Oberteuffer et al., and then to have the data played back simultaneously aurally

and on-screen, as taught by Kono, without regard to the particular input mode (voice or keypad) that was used. For this reason alone, the rejection of Claim 1 and its dependent claims properly should be reversed.

In the final rejection, the examiner admits that Oberteuffer et al. has only a single output mode but argues that Kono "describes a multi mode input but with a multi mode output as well", pointing to col. 1, lines 13-52. This is misleading and in any case insufficient to resolve the deficiency in the rejection noted above. Kono's invention that is actually "described" has only one input mode. Kono does not "describe" anything in its background; in the relied-upon section, it merely mentions that a pocket organizer can be used as a dictaphone. Regardless of whether this constitutes a teaching of plural input modes, it plainly is not a suggestion, much less a teaching, for a particular correspondence between particular input modes and respective output modes.

In addition, the proffered suggestion to combine lacks the requisite prior art motivation. The proffered suggestion to use the multi mode output of Kono with Oberteuffer et al., namely, that to do so "enhances understanding of graphically displayed content", bears no relevance to Oberteuffer et al., which displays no book content at all. Instead, all Oberteuffer et al. does is accept voice input and handwriting input for digitizing them into computer files, something that nothing in the prior art, particularly Oberteuffer et al., suggests must be improved by providing multi-mode output. In other words, the user of Oberteuffer et al. does not seek to access content from anything, but rather to input content already known to the user into a computer file, thus requiring no multi-modal repetitive output of what the user has just input. Consequently, while Kono has a reason for its multi mode output, that reason has no relevance in the context of Oberteuffer et al., the reference sought to be modified. The converse is also true - that while Kono seeks to provide multiple output modes, there is no reason or suggestion in Kono to employ multiple input modes

in lieu of its graphics-only mode, because Kono makes no recognition that would support such a modification in its particular context, see MPEP §2143.01 (the mere fact that a reference can be modified does not render an invention obvious, unless the modification is suggested by the prior art, citing In re Mills). Accordingly, a *prima facie* case of obviousness has not been properly made under the MPEP, because the requisite prior art suggestion to combine the two references is missing, rendering the claims patentable.

In the current rejection, the examiner has augmented the proffered suggestion to combine simply by alleging that Oberteuffer et al. "is able to display content other than what the user puts into it", relying on the Web browser mentioned at col. 4, lines 17-27. This attributes more to Oberteuffer et al. than what the reference actually teaches, which is a device to allow both handwriting and voice to be input and converted to a text document. A more meticulous, in-context reading of the relied-upon section of Oberteuffer et al. reveals that mere mention of the Web browser is not necessarily a teaching that content is downloaded from the Internet:

"Mode controller 102 activates modes in mode processing logic 104 *according to input received from interface controller 106* to create an operating state for computer system 100. An operating state governs how *input received from interface controller 106* is processed and passed to application programs 116. Application programs 116 can include, for example computer programs for creating, editing, and viewing electronic documents, such as word processing, graphic design, spreadsheet, electronic mail, and web browsing programs." (emphasis mine)

Accordingly, to the extent that a browser is mentioned, it is only in the context that it can be used, along with other application program types, to create, edit, and view documents from the interface controller 106, i.e., from the voice and handwriting interfaces 108, 110, which are the only things shown inputting

anything to the interface controller 106. Thus, Appellant's point that all Oberteuffer et al. does is accept voice input and handwriting input for digitizing them into computer files, and that as a consequence the reference fails to provide any reason for using Kono's multi-mode output, remains effectively un rebutted.

Having deconstructed the *prima facie* case, Appellant respectfully requests reversal of the rejection of Claim 1 and its dependent claims.

**(8b) Argument**

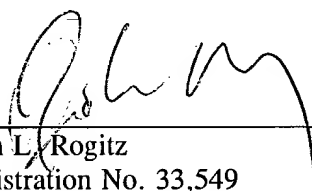
Because the references are not properly combinable owing to the lack of a prior art motivation to do so as detailed above, the rejection of Claim 13 and its respective dependent claims should be reversed.

Moreover, nothing in the relied-upon references suggests maintaining a current position in content and/or a spanning region of the content being rendered such that first and second output threads are run simultaneously with each other, as now set forth in Claim 13, much less do the references teach determining positions at which tangible interfaces should pause when required to coordinate the multiple output modes. The examiner struggles mightily to concoct a rejection, "interpreting" that, since Kono teaches that sound and graphics outputs are synchronized, this means that "the electronic book will pause in order to coordinate the audio and video output". A more comprehensive understanding of what Kono actually teaches reveals that this allegation is incorrect. Nowhere does Kono actually teach just how, precisely, it achieves "synchronization", but at col. 7, lines 30-33 Kono teaches that audio output can "footnote or exemplify" the displayed text, meaning that the audio speech relates to but has a different content from the text which is displayed in response to a user query. Given this, it appears that by "synchronization" all Kono means is that when text is returned to respond to a query, a short audio footnote that is linked to the text is also

played. This does not implicate the need to pause anything because the content of the audio footnote, while related to the text, is not the same as the text and, hence, only a loose coupling such as starting both displays simultaneously need be implemented. For this reason, it appears that the rejection of Claim 13 and its dependent claims should be reversed.

Additionally, there is no teaching or suggestion that user input commands can be received from an audio user interface a graphics user interface updated in response thereto and vice-versa, as required by Claim 13. The Office Action indulges in some pretty creative bending of the references to conjure up this part of Claim 13 and as a result the rejection remains unconvincing.

Respectfully submitted,



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John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

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#### APPENDIX A- APPEALED CLAIMS

1. An electronic book device, comprising:  
a portable housing; and  
a processor in the housing and displaying content stored in a storage device by undertaking at least one of: responding to plural input modes, and outputting the content using plural output modes, wherein the processor responds to a graphics input mode by outputting content in a graphics output mode using a graphic user interface, the processor also responding to an audio input mode by outputting content in an audio output mode using an audio user interface.
2. The device of Claim 1, wherein the plural output modes include at least visual graphics and sound, and the device includes at least one visual display and at least one audio speaker, both being responsive to the processor for outputting content.
3. The device of Claim 2, wherein the processor is responsive to user input selecting an output mode.
4. The device of Claim 1, wherein the plural input modes include at least graphics and sound, and the device includes at least one graphics input device and at least one audio input device, both sending input signals to the processor.
5. The device of Claim 4, wherein the processor is responsive to user input selecting an input mode.
7. The device of Claim 1, wherein the user interfaces run simultaneously with each other.
8. The device of Claim 1, wherein the processor receives for storage annotations from a user-selected one of the user interfaces.
9. The device of Claim 1, wherein the processor is programmed to allow a user to navigate through the content using a user-selected one of the user interfaces.
10. The device of Claim 8, wherein the annotations are associated with user-selected portions of content.
11. The device of Claim 1, wherein the processor receives for storage annotations from a user-selected one of the user interfaces and updates the other user interface with the annotations.

12. The device of Claim 1, wherein the processor is programmed to allow a user to navigate through the content using a user-selected one of the user interfaces to render a navigation result, the processor updating the other user interface with the navigation result.

13. An electronic book, comprising:  
content stored in at least one data storage;  
at least one abstract interface accessing the data storage;  
at least an audio user interface communicating with the abstract interface; and  
at least one graphics user interface communicating with the abstract interface, the abstract interface receiving user input commands from the audio user interface and updating the graphics user interface in response thereto, the abstract interface receiving user input commands from the graphics user interface and updating the audio user interface in response thereto, wherein  
the audio user interface and graphics user interface establish tangible interfaces, and for each tangible interface the abstract interface stores information including a current position in content being rendered and/or a spanning region of the content being rendered, such that first and second output threads are run simultaneously with each other, the abstract interface also determining positions at which tangible interfaces should pause when required to coordinate the multiple output modes.

14. The book of Claim 13, wherein the book includes at least one visual display associated with the graphics user interface and at least one audio speaker associated with the audio user interface.

15. The book of Claim 14, wherein content is output in a graphics output mode using the graphics user interface, content also being output in an audio output mode using the audio user interface.

16. The book of Claim 15, wherein the user interfaces run simultaneously with each other.

17. The book of Claim 15, wherein the annotations from a user-selected one of the user interfaces are stored in the book.

18. The book of Claim 15, wherein a user navigates through the content using a user-selected one of the user interfaces.

19. The book of Claim 17, wherein the annotations are associated with user-selected portions of content.

20. The book of Claim 15, wherein the abstract interface updates one of the user interfaces in response to commands received from the other user interface.